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EXAMINER

WALSH, JOHN B

ART UNIT PAPER NUMBER

3676

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/719,411

Applicant(s)

BUCKER ET AL.

Examiner

John B. Walsh

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period of Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 and 12 is/are rejected.
- 7) ☒ Claim(s) 4 and 9-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Specification*

1. The substitute specification filed February 19, 2003 has been considered and entered by the Examiner.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 5-8 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,927,772 to Antonucci et al.

Antonucci et al. '772 disclose an exterior handle (11) mounted on the exterior skin of a motor vehicle (column 1, lines 19-20) and loaded with a spring force (column 4, lines 16-21); a closing system (25,100) fixed inside the bodywork space of a motor vehicle; the exterior handle has a holding fixture (48) which can be brought into interactive contact with a connecting element (53); one end (figure 2; right end of 53 with 55) of the connecting element is displaceably mounted on an insert part (23,56); the other end (figure 2; left end of 53 with 52) of the connecting element can be connected in active engagement with an actuating element (28) which unlatches a blocking element (100) of the closing system.

As concerns claim 2, the insert part has a closing cylinder (23).

As concerns claim 5, a compressing spring (51) is supported between the insert part and the connecting element to resiliently support the handle (figure 1; 51 is between 53 and outermost portion of 23).

As concerns claim 6, the handle is tensioned with a handle shell through a spring (51).

As concerns claim 7, the insert part can be fixed through at least one opening in an interior skin of the wing (opening in 300; figure 5a; opening extends from exterior to an interior skin).

As concerns claim 8, the insert part is connected for positive locking engagement with a handle shell (connected at 70).

As concerns claim 12, the actuating element is designated as (40) rather than (28) and the blocking element (28) is a locking pawl.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,927,772 to Antonucci et al. as applied to claim 1 above in view of U.S. Patent No. 5,095,659 to Benoit et al.

Antonucci et al. '772 do not disclose illumination means.

Benoit et al. '659 teach illumination means (figure 12 ; 82).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the insert part of Antonucci et al. '772 with illumination means, as taught by Benoit et al. '659, in order to provide a visual means of finding the insert part in the dark.

***Allowable Subject Matter***

6. Claims 4 and 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant's arguments filed February 19, 2003 have been fully considered but they are not persuasive.

The applicant argues Antonucci does not disclose the limitation of claim 1 wherein "a connecting element which can be inserted from the exterior skin." This limitation is drawn to the method of forming the device, which is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

The applicant argues Antonucci does not disclose the limitation of claim 2 wherein "the insert part has a closing cylinder and an infrared receiver." This limitation is not entirely true because claim 2 recites "wherein the insert part has at least one of a closing cylinder and an infrared receiver" (emphasis added). Antonucci does disclose at least a closing cylinder and is therefore not required to disclose an infrared receiver.

The applicant argues Antonucci does not disclose the limitation of claim 5 wherein "a compressing spring is supported between the insert part and the connecting element." The spring (51) is supported between the far right portion of 23 in figure 3 and the far left portion of 53 in figure 3, where the spring is between these two points of reference.

As concerns claim 7, the interior skin of the wing is an interior surface of 300 (figure 5a) and the exterior skin is an exterior surface of 300. The opening in 300 is the opening for the assembly of 11 shown installed in figure 5a.

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As concerns claim 8, the insert part (23) is connected to the handle shell by the opening (70).

As concerns claim 12, the locking pawl is the blocking element, 28 has been designated the blocking element and element 28 is a pawl (column 3, line 38).

As concerns the applicant's arguments to claim 3, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, Benoit et al. '659 teach illumination means (figure 12; 82). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the insert part of Antonucci et al. '772 with illumination means, as taught by Benoit et al. '659, in order to provide a visual means of finding the insert part in the dark. In response to Applicant's argument based upon the age of the references, contentions that the reference patents are old is not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. In re Neal, 179 USPQ 56 (CCPA 1973).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 703-305-0444. The examiner can normally be reached on Monday-Friday from 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-872-9325.

  
Anthony Knight  
Supervisory Patent Examiner  
Technology Center 3670

JW  
July 1, 2003